

REMARKS

The present application relates to hybrid maize plant and seed 34G13. Applicant respectfully requests consideration of the following remarks.

*A. Claim and Specification Objections*

Applicant acknowledges the objection to the specification for containing blank lines in place of ATCC accession numbers on page 7 is now withdrawn. Applicant further acknowledges the objections to claims 1, 5 and 7 are withdrawn in light of the previous claim amendments. The rejection of claims 1-32 under the judicially created doctrine of obviousness-type double patenting is also acknowledged by the Applicant as withdrawn. Applicant further acknowledges the rejection of claims 1-32 under 35 U.S.C. § 102(e)/§103(a) are withdrawn.

*B. Specification*

Applicant submits the Deposit section has been amended in order to properly include both the hybrid maize plant 34G13 and the inbred parents GE486259 and GE515721 within the Deposit paragraph. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The specification has now been amended to correct these minor changes.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 6, 8, 11, 15, 19, 21, 28 and 32 remain rejected and new claims 33, 34 and 38-40 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the Office Action mailed July 29, 2002.

Claims 11, 15, 19, 24, 28 and 32 remain indefinite for the reasons of record stated in the Office Action mailed July 29, 2002. The Examiner further states the specification does not teach that the traits within Tables 1-4 can be described in the manner in the claims.

Applicant has canceled claims 11, 15, 19, 24, 28 and 32, thus alleviating this rejection.

Claim 6 stands rejected as there is improper antecedent basis for the phrase "protoplasts" in line 1.

Applicant has now amended claim 5 to read --a tissue culture of regenerable cells or protoplasts--, thereby alleviating the rejection to claim 6.

The Examiner rejects claims 8 and 21 for the recitation "manipulated to be male sterile" which renders the claim indefinite. The Examiner states it is not clear if the claim is directed towards detassled plants, or plants that have been transformed with a gene conferring male sterility.

Applicant has now canceled claims 8 and 21, alleviating this rejection.

Claims 11, 15, 19, 24, 28, 32, 38 and 39 stand rejected for the recitation "has derived at least 50% of its alleles" in claims 11, 15, 19, 24, 28, and 32, and "deriving at least 50% of its alleles" in claims 38 and 39 which renders the claims indefinite. The Examiner states it is not clear what is meant by "derived" and "deriving".

Applicant has canceled claims 11, 15, 19, 24, 28, 32, 38 and 39, thus alleviating this rejection.

The Examiner rejects claim 33 for the recitation "a hybrid maize plant" in line 4 renders the claim indefinite. The Examiner states the claim does not clearly indicate that the hybrid maize plant in the recitation is the same as 34G13, mentioned in line 1.

Applicant has now amended claim 33, whereby "a" is replaced with --said--, as suggested by the Examiner, alleviating this rejection. Applicant thanks the Examiner for pointing out this inadvertent mistake.

The Examiner rejects claim 34 for the recitation "essentially" in line 3 that renders the claim indefinite. The Examiner states that it is not clear what is encompassed by the term.

Applicant has now canceled claim 34, alleviating this rejection.

Claim 38 stands rejected for the recitation "on average, deriving at least 50%" in line 2 that renders the claim indefinite.

Applicant has canceled claim 38, thus alleviating this rejection.

The Examiner rejects claim 39 for the recitation "A 34G13 maize plant selected from the population of 34G13 progeny maize plants" which renders the claim indefinite.

Applicant has now canceled claim 39, alleviating this rejection.

Claim 40 stands rejected for the recitation "further comprising applying double haploid methods" renders the claim indefinite. The Examiner states it is not clear what double haploid method breeding is being referred to.

Applicant has canceled 40, thereby alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 11-19 and 24-32 remain rejected and claims 9, 10, 22, 23, 34-40 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office Action mailed July 29, 2002. The Examiner states that the deposit with the ATCC does not affect the rejected claims as they are not directed towards the deposited seed or the plant that it is produced from. The Examiner also states that the claims encompass any and all transgenes, even those that have yet to be isolated for which descriptions are unknown. The Examiner further states the specification does not describe any traits of any inbred plants or any progeny plants produced from 34G13, nor does it mention any double haploid method.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 11-19 and 24-32 and claims 9, 10, 22, 23, 34-40, thus alleviating this rejection.

The Examiner rejects claim 33 as it recites the deposit numbers for two inbred maize plants, and page 7 of the specification indicates that these lines have been deposited with the ATCC however, the Examiner states the terms of this deposit are not known.

Applicant respectfully traverses this rejection. Applicant respectfully submits that an actual ATCC deposit has been made for the inbred parents GE486259 and GE515721 as indicated in the October 29, 2002 Amendment. In addition, the specification was amended on page 7 to include the ATCC deposit numbers and dates of deposit of both inbred parent plants. Further Applicant has now amended the DEPOSITS section on page 54 to further include the inbred parents. The Applicant provides assurance that:

- a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

- c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and
- e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 34G13 and inbred parent plants GE486259 and GE515721 have been deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02) Such action is respectfully requested.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 9-19 and 22-40 under 35 U.S.C. § 112, first paragraph.

Applicant acknowledges that claims 1-5, 7 and 20 are allowed.

### Conclusion

In conclusion, Applicants submit in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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